

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: FRANKHUISEN

Confirmation No. 9171

Application No.: 10/552,880

Filed: October 12, 2006

Group Art Unit: 1794

Examiner: WOOD, Ellen S.

Attorney Docket No.: 784-107 (177490)

Customer No.: 30448

For: LABEL FOR WET APPLICATIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action dated March 3, 2010 (the "Office Action"), Applicant respectfully files herewith a Notice of Appeal and requests review of the present application before filing an appeal brief.

I. Related Appeals

The issues presented in the present application are not related to any pending appeal.

II. Status of the Claims

Claims 1-24 are pending in the present application. Independent claims 1 and 16, and dependent claims 2, 4-11, 15 and 17-24, stand finally rejected under 35 U.S.C. §102(b) as being anticipated by PCT Publication No. WO91/16025 to Samonides (hereafter "*Samonides*"). Independent claim 1, and dependent claims 2-6, 10, 15 and 23, stand finally rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 10-180970 to Akio ("*Akio*"). Claims 12-14 stand finally rejected under 35 U.S.C. §103(a) as being obvious over *Samonides*.

III. Clear Errors for Review

Applicant respectfully asserts that the prior art of record fails to disclose each and every element of the claims.

The Office Action asserts that *Samonides* discloses a pre-printed label, which is asserted to consist of a carrier sheet (outer layer) which may be a white kraft paper (page 13, paragraph 1). Thus, the outer layer is asserted to have an opacity. A transparent face sheet (under layer) is asserted to be extruded onto the carrier sheet (page 13, paragraph 3), and that the face sheet may be transparent. It is asserted to be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain.

This is in clear error in relation to the teaching of *Samonides*. As discussed in the amendment filed November 24, 2009, the carrier sheet 4 of *Samonides* discussed on page 13 relates to the first embodiment of label discussed in *Samonides* with respect to Figs. 1-6, and does not form part of the finished label. It "consists of the carrier or liner 6" (page 13, line 5) which has been "coated on its top surface with a suitable release coating 8" (page 8, lines 4-5). Page 8, lines 5-6 states that "[t]he composition of the liner 6 is not important." Notably, the composite carrier sheet 4 is removed from the adhesive backed label once the label is in place. Printing 28 is applied onto the adhesive layer 22, and a transparent face sheet 40 is extruded onto the printing indicia 28. Page 13, second paragraph states "the composite carrier sheet 4 may be readily peeled from the adhesive layer 22 without removing the adhesive from the transparent face sheet 40." The carrier merely acts to carry the label prior to application. Once the carrier sheet 4 is removed, the label can be applied to a surface using adhesive layer 22, leaving the face sheet 40 as the outer layer. The printing 28 is visible from the top, through the transparent face sheet 40. The Office Action asserts that the face sheet 40 would retain its opacity when exposed to moisture or liquid, and this is thus in direct contrast with the present claims, which require that the outer layer of the label has an opacity that reduces after the outer layer is exposed to moisture or liquid.

In the second embodiment of *Samonides*, shown in Figs. 7-12, a film 64 has printing 78 applied thereto, and a transparent adhesive layer 90 is extruded onto the top surface of the film 64 carrying the printing 78. A carrier sheet 96 having a release coating 98 is laminated onto the adhesive layer 90. In use, the carrier sheet 96 is removed, and the label applied to a surface such as a clear glass bottle. The printing 78 is visible through the adhesive, through the underside of the label.

In both embodiments of label disclosed in *Samonides*, therefore, the printing 28, 78 is sandwiched and protected between a sheet (the face sheet 40 or the film 64) and an adhesive layer 22, 90. Either the sheet or the adhesive layer is transparent, and the other layer may be opaque so that the protected printed indicia is visible through the transparent layer. *Samonides* teaches that the protection of the printing indicia with a transparent layer is important to preserve the finished appearance of the label. Furthermore, *Samonides* makes no reference to any change in the opacity of any of the labels upon exposure to moisture, which is required in the present claims.

Yet further, not only do the present claims require that the outer layer has an opacity that reduces after exposure to moisture, which is not taught by *Samonides*, the present claims also require that the outer layer receives the printed indicia. This is also clearly not shown by *Samonides*, which teaches that the printed indicia should be on an inner, protected layer. The printed indicia on the labels defined in the present claims is not protected by a transparent outer layer, but is still readable even when the outer layer has been exposed to moisture, due to the opacity of the inner layer remaining unaffected by the moisture. The labels of the present claims retain the look and feel of a traditional paper label, but have readability advantages over the traditional labels. This is clearly not taught or suggested by *Samonides*, and the present claims are thus believed to define patentable subject matter.

Akio has not been discussed in any previous Office Action. Applicant submits that the citation of *Akio* as a §102(b) reference is a clear error, as *Akio* omits one or more essential elements needed for a *prima facie* 102(b) rejection.

First, both claims 1 and 16 of the present application claim a label. *Akio* relates to paper, which may be used in printers such as ink jet printers. While a piece of paper could be used to make a label, the two items are not the same. The Examiner states that "the broadest reasonable interpretation would define a label as a printed surface," however MPEP §2111 confirms that "[t]he broadest reasonable interpretation must also be consistent with the interpretation that those skilled in the art would reach." MPEP § 2111.01 confirms that the broadest reasonable interpretation must be made "in light of the specification" and that words in the claims must be given their plain meaning, unless the plain meaning is inconsistent with the specification. The Examiner has erred in not considering the plain meaning of the term "label," nor the meaning that is consistent with the understanding of those skilled in the art.

In dictionary.com, the definition of label when used as a noun is given as:

1. a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc.
2. a short word or phrase descriptive of a person, group, intellectual movement, etc.
3. a word or phrase indicating that what follows belongs in a particular category or classification: *The following definition has the label "Archit."*
4. *Architecture* . a molding or dripstone over a door or window, esp. one that extends horizontally across the top of the opening and vertically downward for a certain distance at the sides.
5. a brand or trademark, esp. of a manufacturer of phonograph records, tape cassettes, etc.: *She records under a new label.*
6. the manufacturer using such a label: *a major label that has produced some of the best recordings of the year.*
7. *Heraldry* . a narrow horizontal strip with a number of downward extensions of rectangular or dovetail form, usually placed in chief as the cadency mark of an eldest son.
8. *Obsolete* . a strip or narrow piece of anything.

It is submitted that what is being claimed as a "label" falls within definition 1 above. That is, what is required to anticipate claim 1 is a slip of paper or the like which is to be affixed to something to indicate its manufacturer, nature, ownership, destination, etc. Thus, a piece of paper for use in printers is not a label because it does not indicate anything.

Second, *Akio* teaches that the outer paper layer is transparent. Paragraph 15 of *Akio* states:

"In the laminated body of this invention, transparent pulp paper is used as the surface layer, and a body with a high degree of whiteness is used as the opaque support body layer. In this way, a laminated body that exhibits a high degree of whiteness, in accordance with the degree of whiteness of the support body layer can be obtained. The laminated body appears to have a high degree of whiteness because the surface layer is transparent pulp paper and the lower layer, the highly white support body, can be seen through it."

The surface pulp layer 1 thus does not have an opacity "that reduces after the outer layer is exposed to moisture or liquid" as required by the present claims, because it is transparent. There is no teaching or suggestion in *Akio* regarding the Examiner's assertion that the surface pulp layer has an opacity nor that it reduces on exposure to moisture or liquid. As for the Examiner's assertion that it is not necessary to take this into account because it "is functional language of just the outer layer material and does not give rise to the function of the label," this

is believed in error because the label is of laminate construction, and the function of one layer is clearly inextricably tied to the function of the entire label. The specification makes clear that this reduction in opacity is very much a function of the label.

For at least these reasons, claims 1 and 16 are believed to be patentable over the cited references. The dependent claims are also believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. Accordingly, it is respectfully submitted that the claims are in condition for allowance and clear error has been committed in the Office Action. The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account Number 50-0951.

Respectfully submitted,

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